

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter that applicants regard as the invention.

Claims 1-27 remain in this application.

Claims 26 and 27 were rejected under 35 U.S.C. §102(b) as being anticipated by Brillhart *et al.* (U.S. 5,303,306). For the following reasons, the rejections are respectfully traversed.

The Examiner argued that the limitations directed toward adjusting parameters for “better understanding” and “more pleasant hearing” were given no patentable weight, because it was not limiting upon a structure that was positively recited (a receiving device). The claims have been amended to positively recite the hearing device, which is the receiving device, and thus the Examiner must consider the cited limitations. Note that applicant’s representative could find no such teachings in the cited reference.

Claims 1-5, 7-9, 12-17, 21/15, 21/16, 21/17, 21/20, 23/15, 23/16, 23/17, 23/20, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brillhart *et al.* in view of Mansgold *et al.* (U.S. 4,425,481). The remaining claims were rejected under 35 U.S.C. §103(a) as being unpatentable as above in view of one or more of Topholm (U.S. 4,947,432), Meyer (U.S. 5,604,812), and Saur. For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites the steps of “automatically adjusting parameters of a parameter set including parameters other than volume saved in the hearing device and belonging to the identified momentary surround situation with the aid of an input unit operated by the hearing device user in accordance with the hearing desire of the hearing device user” and also a step of “manually adjusting parameters including parameters other than volume of said parameter set further in accordance with the hearing desire of the hearing device user so as to fine tune said parameter set”. Claim 15, as amended, recites similar limitations. The cited references do not teach such “automatic” and then “manual” adjustments.

None of the references teach the ability to adjust parameters *both* automatically and manually to fine tune the adjustment, as recited in the claims. At most, Mansgold, as cited by the Examiner, might teach that an adjustment of a hearing device can be manually adjusted by remote control, *or alternatively* an automatic adjustment may be utilized (see, for example, col. 2, lines 15-17 and col. 3, lines 6-8). However, there is no teaching of both automatic and manual adjustment being done on the same parameters.

Furthermore, the Mansgold reference appears to teach that the user can only chose from a predetermined set of discrete, predetermined parameters (see col. 4, lines 50-68). There is no suggestion that the user can “fine-tune” these parameters; instead, the reference merely teaches the ability to choose from a number of specific, predetermined listening situations (e.g., a course adjustment).

Brillhart, like Mansgold, teaches the selection of predetermined discrete listening situations (see col. 3, lines 38-42), while permitting a manual adjustment of volume on the remote control (see col. 3, lines 46-47), without any teaching of manually fine-tuning of any non-volume parameters. Furthermore, Brillhart also fails to teach both the automatic adjustment, and then manual fine-tuning adjustment, of the parameters (including more than just volume). Instead, only manual adjustments appear to be provided for, with no suggestion of providing both in sequence. None of the additional references overcome these shortcomings.

Accordingly, claims 1 and 15 are patentable over the references. The remaining claims, which depend, directly or indirectly, upon one of claims 1, 15, and 26, are thus patentable over the references for at least the same reasons as the parent claims.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of

one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner provides generalized insufficient motivations, such as arguing that the modifications are for the “convenience of the user” or for providing “advantages”, which are clearly not legally sufficient motivation to support a prima facie case of obviousness. Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35469US1.

Respectfully submitted,
PEARNE & GORDON, LLP

By: / Robert F. Bodi /
Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

February 23, 2007